



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,036	01/31/2001	Joseph M. Probst	04645.0558	5492

7590

11/01/2002

David L. Principe
Hodgson Russ LLP
One M&T Plaza, Suite 2000
Buffalo, NY 14203-2391

EXAMINER

CANTELMO, GREGG

ART UNIT

PAPER NUMBER

1745

7

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,036	PROBST ET AL.	
	Examiner	Art Unit	
	Gregg Cantelmo	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 10 October 2002.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-8 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> .	6) <input type="checkbox"/> Other:

DETAILED ACTION

Response to Amendment

1. In response to the amendment received October 1, 2002:
 - a. Claim 9 has been cancelled as per Applicant's request.

Election/Restrictions

2. Applicant has elected Group I, claims 1-8 without traverse. Group II, claim 9 has been cancelled as per Applicant's request.

Information Disclosure Statement

3. The information disclosure statement filed April 4, 2001 has been placed in the application file and the information referred to therein has been considered as to the merits.

Drawings

4. The drawings are objected to. Fig. 1 appears to have an inset Fig. 2 (first sheet of the drawings). However this Fig. 2 inset is not the same as what is shown in Fig. 2 (second sheet of the drawings). In addition recitation of the labels Fig. 1 and Fig. 2 in the same figure is objected to since each figure should be a separate and distinct figure. A proposed drawing correction or corrected drawings are required in reply to the Office

Art Unit: 1745

action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities: the U.S. Patent No 575,286 on page 6, line 24 is not assigned to the assignee of this application and does not appear germane to the instant invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-4, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 is indefinite. Therein claim 2 recites that the current collector screens (plural) are connected to the support member through an external tab (singular) extending from the current collector screen (singular). The claim language does not clearly indicate the nature of the external tab relative to the screens. First, it is unclear how all of the current collectors are connected through the support through a single external tab. Second there are plural current collectors in the claim and the particular current collector at the end of claim 2 is not clearly identified. The claim has been

Art Unit: 1745

interpreted in light of the specification in that each current collector screen from the plurality of current collector screens is connected to the support member through a respective external tab.

9. Claim 3 recites the limitation "the substantially same position" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. In particular there is no antecedent basis for the position of all of the current collectors to be in such a positional relationship.

10. Claim 3 recites the limitation "the common carrier screens" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. The term should be the "current collector screens" as supported in claim 1.

11. Claim 4 recites that there is a "secondary material" disposed on the surface of the current collector screens. The term secondary renders the number of materials present in the invention of claim 4 indefinite. Is the secondary material a second material disposed on the screens (thus meaning that there would be a primary material also disposed on the surface of the current collector screens) or a secondary material apart from a primary material being the carrier itself (integral support member and screens)? The examiner has interpreted the limitation in light of the specification to be a material apart from a primary material being the carrier itself (see page 2, lines 17-24 of the instant specification). This also applies to claim 8.

12. Claim 6 is indefinite. Therein claim 6 recites that the current collector connects to the support member through an external tab. Claim 5 recites plural current collectors, where claim 3 is drawn to a particular current collector. It is not clear which current

Art Unit: 1745

collector of the plurality the limitations of claim 6 are drawn to. The claim has been interpreted in light of the specification in that each current collector screen from the plurality of current collector screens is connected to the support member through a respective external tab.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,712,299 (Loewen).

Loewen discloses a common carrier comprising: an elongate support member 30 having a plurality of locating holes 12 disposed thereon, a plurality of current collector screens 8 integrally formed with and extending from a portion of support member 30 (Fig. 1). More clearly with respect to the current collector screen limitation. The term current collector is broadly interpreted as any collector material that can collect a current. Metal materials would be a broad example since metals are known to amass and conduct current. Thus Loewen, teaching that the sheet is a metal is a broad teaching of a current collector. Further the structure of the collectors is disclosed as a screen, but the particulars of the screen is not further defined. Thus a substrate having openings therethrough defines a particular screen pattern. The material of the sheet is

Art Unit: 1745

a metal (abstract) thus members 8 are current collectors. Members 8 further have openings formed therethrough and thus are considered to be screens of the patterns shown in Fig. 1 (as applied to claim 1).

The current collector screens 8 are connected to the support member 30 through respective external tabs 14 extending from the current collector screen (Fig. 1 as applied to claim 2).

The current collector screens 8 are spaced apart equidistant from one another and are all oriented in the same position relative to the support member 30 (Fig. 1 as applied to claim 3).

The contacts receive a coating with a highly conductive metal (col. 2, ll. 40-42 as applied to claim 4).

Loewen discloses a common carrier comprising: an elongate planar support member 30 having at least one datum (holes 12), a plurality of current collector screens 8 integrally formed with and extending from a portion of support member 30 (Fig. 1). More clearly with respect to the current collector screen limitation. The term current collector is broadly interpreted as any collector material that can collect a current. Metal materials would be a broad example since metals are known to amass and conduct current. Thus Loewen, teaching that the sheet is a metal is a broad teaching of a current collector. Further the structure of the collectors is disclosed as a screen, but the particulars of the screen is not further defined. Thus a substrate having openings therethrough defines a particular screen pattern. The material of the sheet is a metal (abstract) thus members 8 are current collectors. Members 8 further have openings

Art Unit: 1745

formed therethrough and thus are considered to be screens of the patterns shown in Fig. 1 (as applied to claim 5).

With respect to the article of claim 5 capable of being oriented with respect to a tool through the datum:

As discussed above, Loewen teaches of plural holes 12 (datum) to guide the strip of metal through a tool (col. 4, ll. 23-26). Applicant is further reminded that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). As applied to claim 5.

Art Unit: 1745

The current collector screens 8 are connected to the support member 30 through respective external tabs 14 (Fig. 1 as applied to claim 6).

The external tab 14 connects at a substantially perpendicular orientation with the support member 30 (Fig. 1 as applied to claim 7).

The contacts receive a coating with a highly conductive metal (col. 2, ll. 40-42 as applied to claim 8).

15. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,220,230 (McDowell).

McDowell discloses a common carrier comprising: an elongate support member having a plurality of locating holes 17 disposed thereon, a plurality of current collector screens 29 integrally formed with and extending from a portion of the central support member 30 (Fig. 6 as applied to claim 1). See marked-up Fig. 6 below.

The current collector screens 29 are connected to the central support member through respective external tabs 28 extending from the current collector screen (Fig. 1 as applied to claim 2).

The contacts receive a paste coating (col. 1, ll. 15-19 as applied to claim 4).

Loewen discloses a common carrier comprising: an elongate planar central support member having at least one datum (holes 17), a plurality of current collector screens 29 integrally formed with and extending from a portion of the central support member (Fig. 1 as applied to claim 5). See marked-up Fig. 6 below.

With respect to the article of claim 5 capable of being oriented with respect to a tool through the datum:

Art Unit: 1745

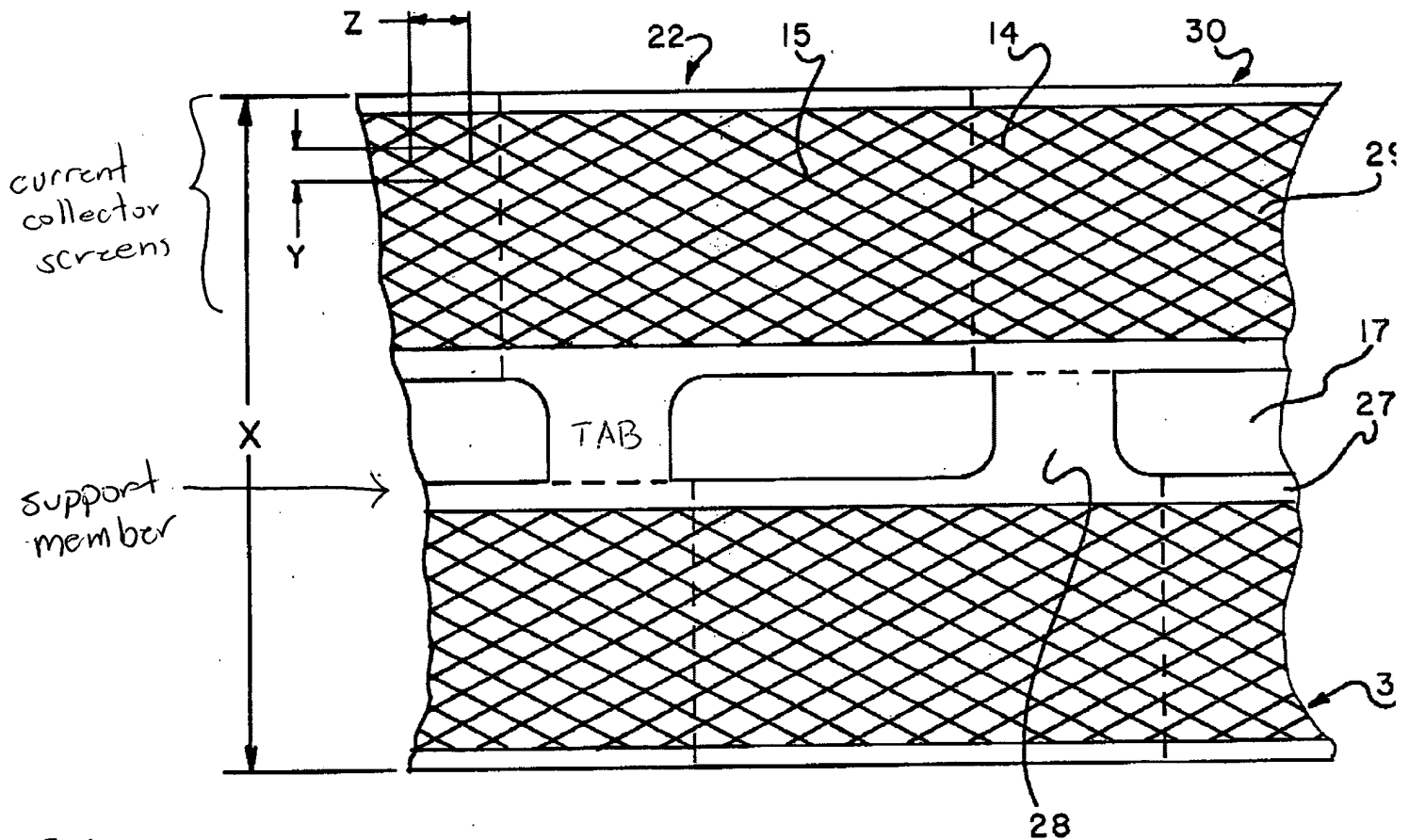
Applicant is reminded that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

While intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). As applied to claim 5.

The current collector screens 29 are connected to the central support member through respective external tabs 28 (Fig. 1 as applied to claim 6).

The external tab 28 connects at a substantially perpendicular orientation with the central support member (Fig. 1 as applied to claim 7).

The contacts receive a paste coating (col. 1, ll. 15-19 as applied to claim 8).



G1C
10/30/02

FIG. 6

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (703) 305-0635. The examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (703) 308-2383. FAX communications should be sent to the appropriate FAX number: (703) 872-9311 for After Final Responses only; (703) 872-9310 for all other responses. FAXES received

Art Unit: 1745

after 4 p.m. will not be processed until the following business day. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gregg Cantelmo
Patent Examiner
Art Unit 1745

gc



October 30, 2002